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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,322	11/06/2001	Derry Roopenian	JL-2010	5668
28120	7590	12/28/2004	EXAMINER	
ROPES & GRAY LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110-2624			LI, QIAN JANICE	
			ART UNIT	PAPER NUMBER
			1632	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,322

Applicant(s)

ROOPENIAN, DERRY

Examiner

Q. Janice Li

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46, 57-80, 85 and 86 is/are pending in the application.
- 4a) Of the above claim(s) 1-29, 31-46 and 65-80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30, 57-64, 85 and 86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10/8/04, 6/28/06
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The amendment, and response filed 10/8/2004 have been entered. Claims 47-56, 81-84 have been canceled. Claims 30, 57, 61, 85, 86 have been amended. Claims 30, 57-64, 85, and 86 are under current examination.

Unless otherwise indicated, previous rejections that have been rendered moot in view of the amendment to pending claims will not be reiterated.

Specification

The reply filed on 10/8/04 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): The amendments to the claims do not comply with the Revised Amendment Practice of 37 CFR 1.121 (See OG Notice 23 September 2003). Specifically, the text of canceled claims must be omitted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 85 is rejected under 35U.S.C. 112 first paragraph, because the specification as originally filed does not describe the invention as now claimed. The original disclosure fails to teach a candidate agent formulated with a tractable

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composition that is not attached to the tractable composition as now claimed. The subject matter is now considered to be new matter.

In the response to previous objection of claim 85, Applicants indicated that claim 85 covers methods in which a candidate agent is itself tractable without being attached to a tractable composition.

The argument has been fully considered but applicant fails to point specifically to the specification where the support for the new claim could be found.

MPEP 2163.06 notes "WHEN AN AMENDMENT IS FILED IN REPLY TO AN OBJECTION OR REJECTION BASED ON 35 U.S.C. 112, FIRST PARAGRAPH, A STUDY OF THE ENTIRE APPLICATION IS OFTEN NECESSARY TO DETERMINE WHETHER OR NOT "NEW MATTER" IS INVOLVED. *APPLICANT SHOULD THEREFORE SPECIFICALLY POINT OUT THE SUPPORT FOR ANY AMENDMENTS MADE TO THE DISCLOSURE*" (emphasis added). MPEP 2163.02 teaches that "WHENEVER THE ISSUE ARISES, THE FUNDAMENTAL FACTUAL INQUIRY IS WHETHER A CLAIM DEFINES AN INVENTION THAT IS CLEARLY CONVEYED TO THOSE SKILLED IN THE ART AT THE TIME THE APPLICATION WAS FILED...IF A CLAIM IS AMENDED TO INCLUDE SUBJECT MATTER, LIMITATIONS, OR TERMINOLOGY NOT PRESENT IN THE APPLICATION AS FILED, INVOLVING A DEPARTURE FROM, ADDITION TO, OR DELETION FROM THE DISCLOSURE OF THE APPLICATION AS FILED, THE EXAMINER SHOULD CONCLUDE THAT THE CLAIMED SUBJECT MATTER IS NOT DESCRIBED IN THAT APPLICATION". In the instant case, the specification as originally filed describes "A formulation comprising a candidate agent for FcRn-mediated drug delivery is attached or associated with a tractable composition" (Specification, page 25, lines 29-32). The specification fails to teach a candidate agent is by itself tractable. Thus, the amendment is a departure from or an addition to the

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disclosure of the application as filed, accordingly, it introduces new matter into the disclosure.

For reasons set forth above, the amendment filed 10/4/04 is objected to under 35 U.S.C. §132 because it introduces new matter into the disclosure. 35 U.S.C. §132 states that no amendment shall introduce new matter into the disclosure of the invention. Applicant is required to cancel the new matter in the reply to this Office Action. Alternatively, Applicant are invited to specifically point out where in the specification the support can be found for the amendment made to the disclosure.

To the extent that the claimed invention is not described in the instant disclosure, claim 85 is also rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, since a disclosure cannot teach one to make or use something that has not been described.

Claims 57-60 and 85 stand rejected and claims 30, 61-64, 86 are newly rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claimed methods are assays for FcRn mediated drug stability, which require the interaction of a testing agent with FcRn molecule. Since the FcRn molecule is

expressed in the vascular endothelial cells, the candidate agent is required to reach the bloodstream, and since the half-life of the agent is measured using blood or serum sample, the candidate agent is also required to reach the bloodstream. However, the claims encompass administering a formulation such as IgG and IgA to a transgenic mouse via any route including any non-intravenous route, and the specification fails to teach whether the non-intravenous routes such as oral, aerosol, nasal administration would deliver sufficient amount of the formulation to the bloodstream so that a measurable difference could be seen. In fact, the specification teaches, "Optimally, the tracer IgG and IgA is administered intravenously" and "The use of alternate routes of administration in the method incorporates an implicit test of candidate inhibitor targeting to the bloodstream as well as activity" (Specification, page 20, lines 1-8), which indicates that the alternate routes are insufficient unless the candidate agent has the ability to target to the bloodstream. Apparently, any alternate route other than intravenous would require further research on the property of the candidate inhibitor, to determine whether it could reach the bloodstream and in a sufficient capacity, which is a different task compared to the claimed invention. Thus undue experimentation is required.

It is noted that the means of delivery provided in the specification is the intraperitoneal route, compositions administered by i.p. are known to reach the circulation reasonably well, whereas a protein formulation may be destroyed before it reaches the bloodstream when administered via oral route. Moreover, non-intravenous administration encompasses the intracardiac administration, which would deliver the

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formulation directly to the bloodstream, and which formulation would then be eliminated rapidly, which does not appear to be desired for the claimed invention.

Therefore, in view of the guidance of the specification, the knowledge of the skilled in the art, and the breadth of the claims, one skill in the art could not practice the invention without undue experimentation as it is broadly claimed.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Q. Janice Li** whose telephone number is 571-272-0730. The examiner can normally be reached on 9:30 am - 7 p.m., Monday through Friday, except every other Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Amy Nelson** can be reached on 571-272-0804. The fax numbers for the organization where this application or proceeding is assigned are **703-872-9306**.

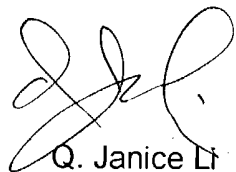
Any inquiry of formal matters can be directed to the patent analyst, **Dianiece Jacobs**, whose telephone number is (571) 272-0532.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance.

Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.



Q. Janice Li
Primary Examiner
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December 23, 2004